

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Application No. : 10/621,152
Applicant : Alfred Thomas
Filed : July 15, 2003
Title : Method And Apparatus For Changing An Appearance Of
Mechanical Devices Displayed On A Gaming Machine
TC/A.U. : 3714
Examiner : Frank M. Leiva
Docket No. : 247079-00219USPT
Customer No. : 70243

MS Appeals
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REPLY BRIEF PURSUANT TO 37 C.F.R. § 41.37

Dear Commissioner:

This Reply Brief is filed in support of Appellants' appeal to the Board of Patent Appeals and Interferences ("Board") from the rejection of claims 1, 3-7, 11-23, 25-26, and 30 in the September 16, 2009 Final Office Action. (Exhibit B¹). An Examiner Answer brief was filed July 12, 2010 ("Answer") and there the due date for this Reply Brief is two months from the mailing date of the Answer and this brief is being timely filed.

In the previous Appeal Brief, Applicant argued that: a) the cited Satoh, Inoue and Jasper references were improperly combined because each separate reference includes features such as a dual reel set in Inoue or using a subset of reels for the bonus game in Jasper which could not be combined with Satoh and function as Satoh was intended; and b) the combination of references does not disclose using the same reels for both the bonus and basic games. The Answer has

¹ In this paper, Applicants will reference Exhibits attached to the original Appeal Brief previously filed

continued to impermissibly use the claim elements as a template for picking out isolated elements of Inoue and Jasper to fill in the missing claim elements to Satoh. There is no rationale for why one or ordinary skill would combine the references especially since such combinations change the fundamental operation of Satoh.

ARGUMENT: THE COMBINATION OF ELEMENTS OF INOUE AND JASPER WITH SATOH IS IMPROPER

A The Combination of Inoue with Satoh Is Improper Because Inoue Teaches Away From The Single Set Of Reels In Satoh And Changing the Appearance Of The Reels Used For The Basic Game.

As explained in the initial brief, Inoue discloses a separate set of reels 6a-6e in Fig. 1 to play the bonus game and a set of reels 5a-5c whose appearance does not change during the bonus game. (Ex. D, ¶¶ 30, 35, 42 and 43). The combination of Inoue with Satoh would therefore not anticipate the claims that require changing the appearance of the reels in the basic game to play the bonus game. The Answer has asserted that “the entire disclosure of Inoue is not being incorporated into Satoh, only the teaching that the lighting effects during the bonus round are maintained” in the bonus round. (p. 10). The Answer has ignored the disclosure in Inoue that the base reels do not change their appearance during the bonus game. The Answer has failed to disclose why the features of the separate, secondary reels (Ex. D, elements 6a-c) used exclusively for a bonus game in Inoue may be applied to Satoh without importing the existence of the second set of reels themselves. The addition of another set of reels would destroy Satoh’s fundamental purpose of using reels for dual purposes.

B. The Combination of Jasper with Inoue and Satoh Does Not Disclose Using All Of The Same Mechanical Reels For The Bonus And Base Games

As explained in the initial Brief, if the mechanism disclosed by Jasper were combined with Satoh, a subset of the base game reels would have be used (Jasper) in order to provide the

different mathematical odds for the bonus game and therefore not anticipate the claims at issue. The Answer has asserted that claims 1, 5 and 6 of Jasper include a single set of reels that could be a complete set of reels. (pp. 10-11). However, these claims actually support Applicant's position that Jasper teaches a different number of reels for the base and bonus games thereby resulting in different mathematical models for each. Specifically, claim 1 of Jasper requires a first subset for the basic game and a distinct, second subset for the base game. (Ex. E). Claim 5 of Jasper discloses that the first subset is the number of the set of reels while claim 6 requires that "the **second subset of reels is a proper subset of the set of reels.**" (Ex. E, emphasis added). Thus, claims 5 and 6 teach that the number of reels used in the base and bonus game are different and therefore not every base game reel would be used for the bonus game. Applying Jasper to Satoh would therefore not use all of the same mechanical reels for both the basic game and the bonus game as required by the claims.

CONCLUSION

For at least the foregoing reasons, the final rejection of appealed claims 1, 3-7, 11-23, 25-26, and 30 set forth in the Final Office Action mailed September 16, 2009, should be reversed.

Respectfully submitted,

Date: September 13, 2010

/Wayne L. Tang, Reg. No. 36,028/
Wayne L. Tang
Reg. No. 36,028
NIXON PEABODY, LLP.
161 N. Clark Street, 48th Floor
Chicago, Illinois 60601-3213
(312) 425-3900
Attorney for Applicants